

**REMARKS**

**Summary of the Office Action**

Claims 1-2, 4-6, 14-17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,167,235 to Seacord et al. (hereinafter Seacord).

Claims 1, 4-6, 9-10, 12, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,018,872 to Suszynski et al. (hereinafter Suszynski).

Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of U.S. Patent No. 4,775,586 to Bohrn et al. (hereinafter Bohrn).

The Examiner is thanked for indicating that claims 7-8 include allowable subject matter.

**Summary of the Response to the Office Action**

Applicants have amended independent claims 1 and 17 to differently define the invention and also amended claims 1, 2, 4, 7-10, 12-17 and 19 to improve their form. Accordingly, claims 1, 2, 4-10 and 12-19 remain pending for further consideration.

**All Claims Comply with 35 U.S.C. § 103**

Claims 1-2, 4-6, 14-17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord, claims 1, 4-6, 9-10, 12, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski, and claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of Bohrn. To the extent that these rejections might be reapplied to the claims as newly amended, they are respectfully traversed as

being based on a combination of references that neither teaches nor suggests the novel combination of features now recited in the claims.

With respect to independent claim 1, as newly-amended, Applicants respectfully submit that Seacord does not teach or suggest a claimed combination including at least a feature of “the base body includes at least one air chamber at least in parts to improve heat insulation between the temperature measurement probe and the body cavity.” The Office Action primarily relies upon Seacord and Suszynski to allege that each of the two applied references discloses the invention of independent claim 1. Applicants respectfully disagree with this assertion in the Office Action.

Specifically, regarding Seacord, Applicants respectfully submit that Seacord does not disclose a disposable protective cap as recited in newly-amended independent claim 1. The Final Office Action appears to suggest a disposable sheath 16 of Seacord as the claimed “base body.” However, the disposable sheath 16 of Seacord, as shown in FIG. 2 and as described in last two lines of col. 3, does not includes any air chamber. In other words, Applicants respectfully submit that Seacord fails to teach or suggest the claimed combination including the feature that “the base body includes at least one air chamber at least in parts to improve heat insulation between the temperature measurement probe and the body cavity,” as recited by newly-amended independent claim 1.

Regarding Suszynski, Applicants respectfully submit that Suszynski does not disclose a disposable protective cap as recited in newly-amended independent claim 1. The Final Office Action appears to suggest a plastic film 43 of Suszynski as the claimed “base body.” However,

plastic film 43 of Suszynski does not include any air chamber as shown in FIG. and as described in col. 4, lines 46-62. In other words, Applicants respectfully submit that Suszynski fails to teach or suggest the claimed combination including the feature that “the base body includes at least one air chamber at least in parts to improve heat insulation between the temperature measurement probe and the body cavity,” as recited by newly-amended independent claim 1.

For similar reasons as those set forth above, Applicants respectfully submit that Seacord and Suszynski, whether taken singly or combined, do not teach or suggest “the protective cap includes a base body having at least one air chamber to improve heat insulation between the temperature measurement probe and the body cavity,” as recited in newly-amended independent claim 17.

Applicants further assert that the Office Action does not rely on Bohrn to remedy the above-noted deficiencies of Seacord and Suszynski. Further, Applicants respectfully submit that Bohrn cannot remedy the deficiencies of Seacord and Suszynski.

As pointed by MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” Thus, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and that the rejections under 35 U.S.C. § 103(a) are improper.

Accordingly, for at least the reasons set forth above, Applicants respectfully assert that the rejections under 35 U.S.C. §103(a) should be withdrawn because Seacord, Suszynski and Bohrn, whether taken singly or combined, fail to teach or suggest each feature of independent

claims 1 and 17, as newly-amended. Furthermore, Applicants respectfully assert that the rejections of dependent claims 2, 4-10, 12-16 and 18-19 should also be withdrawn at least because of their respective dependencies upon newly-amended independent claims 1 and 17 and for the reasons set forth above.

With no other rejection pending, Applicants respectfully submit that claims 1, 2, 4-11 and 12-19 are in condition for allowance.

### **CONCLUSION**

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

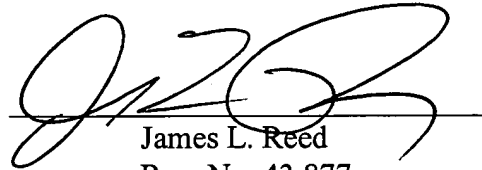
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time

under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By:

A handwritten signature in black ink, appearing to be 'JLR', written over a horizontal line.

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